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REMARKS

Applicants appreciate the courtesies extended to the undersigned during the telephone interview. An interview summary accompanies this response.

Applicants hereby cancel claims 42-61 and add new claims 73-88. Accordingly, claims 62-88 are pending in this application. New claims 73-78 are supported at least by the teachings of the originally-filed specification at page 14, lines 13+. New claims 79-88 are method claims corresponding to the apparatus claims.

Claims 62-72 stand rejected under 35 USC 112, second paragraph, for indefiniteness. Claims 62 and 66-71 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 5,923,834 to Thieret in view of Paton. Claims 62-65, 68 and 72 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 5,305,199 to LoBiondo et al. in view of Paton.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring initially to the indefiniteness rejections, the Examiner indicated that the rejection of "hard imaging" is withdrawn. Additionally, Applicants have amended the claims to generically recite "an expendable" which may correspond to either consumables which are consumed during usage or components which wear during usage. The discussion to generically define and clarify the usage of consumables and components was favorably received by the Examiner during the interview. Applicants respectfully request withdrawal of the 112 rejections or a telephone call to the undersigned in an effort to further the prosecution of the present application with respect to definiteness if the rejections are not withdrawn.

Referring to the 103 rejections, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8<sup>th</sup> ed., rev. 2). Applicants respectfully submit the Office has failed to establish *prima facie* 103 rejections of the claims for at least the following compelling reasons.

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Referring to claim 62, the Office states that the motivation to combine the reference teachings is "to provide a warning when maintenance may have to be performed sooner than expected." Applicants respectfully submit the motivation is presented by the Office is insufficient in view of Federal Circuit authority and the Office has not established a prima facie 103 rejection of claim 62 for at least this reason.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth objective rationale on which it relied.

More specifically, the background of Thieret indicates the reference is concerned with overcoming difficulties with prior art systems and requirements for large data transmission and bandwidth capacities at col. 1, lines 48+. Applicants respectfully submit there is no evidence of record that one of skill in the art aware of the teachings of Thieret would be motivated to look to the cash dispenser prior art of Paton for meaningful teachings. Applicants submit that statements set forth in the present Office Action are akin to the alleged improper motivation discussed *In*

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*re Lee* and accordingly are insufficient to combine the reference teachings.

In addition, there is no evidence of record that one concerned with systems and methods of forming hard images would look to cash dispenser prior art of Paton for meaningful teachings. Paton is void of any teachings regarding hard imaging or expendables thereof.

Furthermore, Applicants respectfully submit that Thieret already provides teachings directed towards alerts (col. 7, lines 60+). Also, Thieret already provides a monitor component 202 which provides suitable data regarding usage of disposable components per col. 9, lines 49+ and there is no evidence of record that improvements to Thieret over the already disclosed teachings of Thieret would be obtained by the combinations of the cash dispenser teachings of Paton to motivate one of skill in the art to combine the reference teachings in the first instance. The motivation provided by the Office is *redundant to the teachings of Thieret* and there is no proper motivation for one of skill in the art to look to Paton for meaningful teachings.

Furthermore, the proposed modification or combination of the prior art would require substantial reconstruction or redesign of Thieret to such an extent the teachings of the combined references are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01(8th ed. rev. 2) *citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The combination of Thieret and Paton is improper for at least this reason.

Applicants also respectfully submit that the combination of LoBiondo and Paton is improper in view of lack of appropriate motivation. As set forth in col. 1, lines 22+, LoBiondo is concerned with overcoming problems of no capabilities for tracking overall inventory of consumable supplies maintained exterior to the machine or to track usage of consumable supplies from a plurality of machines. As set forth by the summary, the reference is directed towards monitoring an inventory of consumable supplies consumed by a plurality of machines. LoBiondo provides at col. 2, lines 54+ a means for monitoring usage and there is no evidence of record that improvements to LoBiondo would be obtained over the already disclosed teachings of LoBiondo by the combination of the cash dispenser teachings of Paton to motivate one of skill in the art to combine the reference teachings. Additionally, significant redesign or reconstruction of LoBiondo would be required to

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accommodate the Paton teachings. Further, the bald cursory motivation provided by the Office is insufficient without objective evidence of record. The 103 rejection of claim 62 over Thieret and Paton is improper for at least these compelling reasons.

Applicants respectfully submit that the 103 rejections over Thieret and Paton, and LoBiondo and Paton are improper for the above-mentioned reasons and claim 62 is allowable.

The claims which depend from independent claim 62 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 67, the claim recites the controller is configured to identify the hard imaging comprising a predetermined type of hard imaging and to adjust the indication of wear responsive to the identification. Applicants respectfully submit the prior art fails to disclose or suggest the limitations of claim 67 even if the references are combined and claim 67 is allowable for at least this reason.

More specifically, on page 5 of the Action, it is alleged that the limitations of claim 67 are well known. The undersigned hereby traverses and seasonably challenges any reliance upon Official Notice pursuant to MPEP §2144.03 (8<sup>th</sup> ed., rev. 2), and requests the Examiner cite a reference or affidavit in support of his or her position in a non-final Action if claim 67 is not allowed.

MPEP 2144.03A (8<sup>th</sup> ed., rev. 2) provides that *official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known*. It is not appropriate for the Office to take official notice of facts without a reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. See *In re Eynde*, 480F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). The Examiner is also reminded

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that claims are analyzed in the context of the combination of the various separately stated limitations, and not with respect to the limitations individually. Pursuant to MPEP §2144.03 (8<sup>th</sup> ed., rev. 2), Applicant hereby requests evidence in a *non-final Action* with respect to what the Examiner apparently relies upon as being "well-known."

Thieret and Paton are void of any teaching or discussion of *identifying the hard imaging comprising a predetermined type of hard imaging and adjusting the indication of wear responsive to the identification* and claim 67 is allowable for at least this reason. Further, the alleged motivation provided by the Office for combining the references "in order to better deal with different types of imaging situations" is conclusory, based upon opinions of the examiner and not based upon objective evidence of record as required for a proper 103 rejection. Applicants respectfully submit claim 67 is allowable for the above-mentioned compelling reasons.

Referring to claims 69-70, it is alleged that disabling a malfunctioning system is well known in the art. Applicants again traverse the taking of Official Notice and traverse the rejection under MPEP 2144.03 and request support by the Office in support of any continued rejection of claims 69-70 in a non-final Action.

As discussed with the Examiner during the interview, even if disablement of a malfunctioning system is "well known," such generic disablement is not sufficient to teach the specific limitations of claims 69-70. More specifically, the respective claims recite the controller configured to disable responsive to the usage information deviating from the usage profile data. The Office in support of the rejection on page 5 of the Action relies upon the teachings of page 4, lines 3-12 of Paton. However, such teachings merely state that a flag is raised when a hardware problem exists and the remote computer 96 provides an indication to an operator that some action is needed when the flag is raised and the operator then takes any necessary action. Accordingly, the combination of prior art and "well known" teachings provides user intervention if a problem is detected and there is no teaching or suggestion of a controller configured to disable responsive to the deviation as positively recited. Claims 69-70 are allowable.

Further, Applicants respectfully submit any modification proposed by the Office to arrive at claims 69-70 based upon Paton is improper in view of the explicit

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teachings of Paton of operator notification and operator intervention and the teachings of Paton would be frustrated by a modification to arrive at the claimed subject matter reciting the claimed controller configured to disable. More specifically, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01 (8<sup>th</sup> ed.) citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). *In re Fitch*, 972 F.2d 1260, 1265 n.12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir. 1992).

Applicants respectfully submit that positively recited limitations of claims 69-70 are not disclosed nor suggested by the prior art and the claims are allowable for these additional reasons.

Referring to claim 72, the Office states on page 6 that even if combined, the combination fails to disclose all of the limitations of claim 72 but still rejects the claim inasmuch as the claims are allegedly well-known. Applicants traverse the reliance upon official notice and request the Office submit evidence in accordance with MPEP §2144.03 in a non-final Action.

In addition with respect to claim 72, the Office relies upon money of Paton as allegedly disclosing the claimed expendable. However, an interpretation of Paton necessary to support a 103 rejection of the claims requires the *monetary budget plan* be with respect to the usage of the expendable comprising money. Further, the interpretation by the Office would also require the determination of monetary cost associated with usage of money and the generation of an alert responsive to the cost exceeding the plan. Applicants respectfully submit a budget plan with respect to usage of money and determining the monetary cost of using money is non-sensical and claim 72 is allowable for these additional reasons.

In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of teachings of specific elements of the prior art which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes*

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*inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable.* Further, no objective evidence of record has been recited in support of the motivation alleged by the Office and the numerous reliances upon official notice are improper. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if the claims are not found to be allowable.

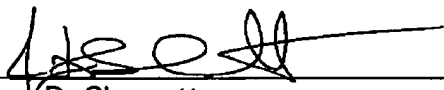
Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Robert Sese et al.

By:

  
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Date: 10/25/05

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